

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1-8 are currently pending in this application.

In the outstanding Office Action, Claims 1 and 8 were rejected under 35 U.S.C. §103(a) as unpatentable over Applicant's Background discussion (herein "Background") in view of JP 406095040A to Saiga et al. (herein "Saiga"); Claims 2-6 were rejected under 35 U.S.C. § 103(a) as unpatentable over Applicant's Background in view of Saiga and U.S. Patent No. 4,563,576 to Matsumura et al. (herein "Matsumura"); and Claim 7 was rejected under 35 U.S.C. §103(a) as unpatentable over Applicant's Background in view of Saiga and U.S. Patent No. 6,163,411 to Touched.

Applicant respectfully submits that the Official Action improperly relies upon the Abstract of Saiga in the 35 U.S.C. § 103 rejections. As the full teachings of this document have not been provided, the finality of the rejection is premature. In this regard, MPEP § 706.02 states:

It is not uncommon for a full text document to reveal that the document fully anticipates an invention that the abstract renders obvious at best. The converse may also be true, that ***the full text document will include teachings away from the invention that will preclude an obviousness rejection*** under 35 U.S.C. § 103, when the abstract alone appears to support the rejection.¹ (emphasis added)

Further, the Board of Patent Appeals and Interferences has held that "the preferred practice is for the Examiner to cite and reply on the underlying document."² The Board's rationale was, in part, that a translation may supply additional relevant evidence on issues of anticipation and obviousness and may eliminate the need for appeal.³ The Board further noted that where

¹ MPEP § 706.02

² Ex Parte Gavin at 62 USPQ2d 1680, 1683 (Bd. Pat. App. Int. 2001).

³ Ex Parte Gavin at 1684.

such a translation is not provided, Applicant is entitled to petition for such a translation prior to appeal.

For the above-stated reasons, the grounds of rejection have not been adequately developed. Further, the reliance on an abstract for supporting a final rejection under 35 U.S.C. § 103 is clearly improper. Accordingly, Applicant respectfully requests that the rejections of Claims 1-8 under 35 U.S.C. § 103, summarized above, be withdrawn, or if the rejections are to be maintained, a full English translation of Saiga be provided and the period for responding to present action be reset in the next Action.

For the sake of facilitating prosecution of the present application, Applicant now addresses the rejection of Claims 1-8 under 35 U.S.C. 103(a) as unpatentable over the Applicant's Background in view of Saiga.

To establish a *prima facie* case of obviousness, M.P.E.P. §2143 requires that three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim elements.

A. The proposed combination does not teach or suggest Applicant's claim limitations.

Applicant respectfully traverses the outstanding ground of rejection because the noted combination of the Applicant's Background and Saiga do not fully meet each of the limitations of independent Claim 1.

Applicant's Claim 1 recites, *inter alia*, an image pickup device including:

... a light shield plate,
wherein said light shield plate prevents interference between a first light flux that passes through said first lens and travels toward said photoreceiving face and a second light flux that passes through said second lens and travels toward said photoreceiving face so that said first and second light fluxes are not overlapped with each other on said photoreceiving face.

The Applicant's Background describes an image pickup device including a plurality of lenses fixed in different locations to transmit light onto a single photoreceiving element.⁴ As depicted in Figures 20 and 21, lenses (3a and 3b) transmit light to create image circles (6a and 6b) on photoreceiving face (10).⁵

Saiga describes an optical axis deviation adjusting device. As shown in Fig. 1, when the mirror (2) deviates from the desired position, leak light (11) will pass the light shield plate (5) and be detected by the photodetector (7). Based upon the amount of light photodetected by the photodetector (7), the controller (9) will adjust the angle and position of the reflecting mirror (2) to obtain proper parallel luminous flux.

The Official Action admits that Applicant's Background does not disclose a light shield plate and Applicant submits that the light shield plate in Saiga does not prevent interference between two light fluxes.

The light shield plate (5) described in Saiga is positioned so that when mirror (2) deviates from the desired position, leak light (11) will be transmitted to the other side of the light shield plate (5). In other words, the light shield plate (5) does ***not prevent*** light from passing from one side of the light shield plate (5) to the other. Moreover, Saiga only discusses light being transmitted to the light shield plate (5) in one direction, from the mirror (2). Specifically, Saiga states one purpose of the optical deviation device is to eliminate "the need to place an extra light source."⁶

⁴ Specification at page 1, lines 38-31.

⁵ Specification at page 1, lines 31-33 and page 2, lines 1-3

⁶ Saiga at Abstract.

The combination of the Applicant's Background and Saiga does not teach or suggest a light shield plate, wherein the light shield plate *prevents interference between a first light flux* that passes through said first lens and travels toward the photoreceiving face *and a second light flux* that passes through the second lens and travels toward the photoreceiving face so that the first and second light fluxes are not overlapped with each other on the photoreceiving face.

The Applicant has found, as shown in Fig. 21 of the present Specification, that there is an overlapped portion between the light from each lens (3a and 3b) and image circles (6a and 6b) preventing the imaging device from obtaining accurate image information in the overlapped portion.⁷ To prevent that overlapping the present invention utilizes a light shield plate that prevents light from opposite sides of the light shield plate from interfering with each other. The Applicant respectfully submits that the teachings in the Applicant's Background and Saiga do not recognize any similar problem or the use of a light shield plate to prevent such interference. In fact, as noted above, Saiga requires the light shield plate (5) therein to only be small enough to allow light from one side to pass to the other side to detect displacement of mirror (2). That operation in Saiga is in contrast to the claimed features in which a light shield plate prevents interference from light on opposite side thereof.

B. There is no motivation to combination the cited references in the manner suggested.

Applicant also respectfully traverses the outstanding ground of rejection because there is no suggestion or motivation for combining the Applicant's Background and Saiga.

The Official Action states that the motivation to combine the Applicant's Background with Saiga is to minimize the quantity of leak light, "thereby obtaining proper parallel

⁷ Specification at page 2, lines 5-10.

luminous flux.”⁸ Further, the Official Action asserts that the Applicant’s Background and Saiga are combinable because they are both “from optical deviation devices.”⁹

While Saiga discusses optical deviation, the Applicant’s Background only describes an imaging receiving device with two lenses that transmits light onto a photoreceiving face. To place the light shield plate (5) described in Saiga in the imaging receiving device of the Background would not alleviate the issue of overlapping image circles (6a and 6b). As previously discussed, the light shield plate (5) of Saiga allows light to pass from one side to the other and thus would not prevent the overlapped portion.

Moreover, the motivation cited in the Official Action, namely “to have the quantity of leak light minimized, thereby obtaining proper parallel flux”¹⁰ is irrelevant to the Applicant’s claimed invention and the Applicant’s Background discussion. The Applicant’s claimed image pickup device and Applicant’s Background are not concerned with deviation of light or lenses, as they are in a fixed structure.¹¹ Applicant respectfully submits that there is no suggestion or motivation to combine Saiga with the structure of the Applicant’s Background.

Accordingly, Applicant submits that independent Claim 1, and Claims 2-7 depending therefrom, are patentably distinguished over the cited combination of references.

⁸ Official Action at ¶5.

⁹ Official Action at ¶5.

¹⁰ Official Action at ¶ 5.

¹¹ Specification at page 1, lines 28-31.

Consequently, in view of the above amendments and comments, it is respectfully submitted that the outstanding rejection is traversed and that the pending claims are in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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